

Application No.: 09/990601

Case No.: 57135US002

REMARKS

In accordance with the request in the Office Action dated March 7, 2006, claim 64 has been amended to clarify its meaning in accordance with the instant application, as filed. The claim as amended, finds antecedent basis, for example, on page 3, lines 17-18, page 7, line 23, and page 8, line 22. No new language has been added to the claim. In addition, claim 64 now contains language already present, for example, in pending claim 53. It is submitted the present wording of claim 64 is well-supported in the application as filed.

The test for determining compliance with the written description requirement of 35 U.S.C. 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *Ex parte Harvey*, 3 U.S.P.Q.2d 1626 (B.P.A.I. 1986). It is submitted this test has been met in instant claim 64.

It is submitted the clarifying amendment to claim 64 is proper at this time because no new issues are raised and this amendment places claim 64 in better condition for allowance and/or in better form for appeal.

Further, as to claim 64, it is alleged in the Office Action (pages 10-11, bridging paragraph) that "in-mold applied" friction material is a method limitation and has been given no patentable weight. Applicants strenuously disagree with this decision by the Examiner. There are no method steps in this claim. This feature of claim 64 finds antecedent basis, for example, on page 5, lines 28-29, of the instant specification. It is well-accepted in patent law that Congress has placed no limitations on how an applicant claims his invention, so long as the specification concludes with claims that particularly point out and distinctly claim that invention. *In re Steppanh, Rebenstock, and Neugebauer*, 156 U.S.P.Q. 143 (CCPA 1967). Further, where the chemical identity of a material is not critical, an applicant should be permitted to define that material in terms of its physical properties or the function that it performs. *In re Metcalfe and Lowe*, 161 U.S.P.Q. 789,793 (CCPA 1969), a decision upheld many times, including in *Ex parte Gleixner, Muller, and Lehrach*, 214 U.S.P.Q. 297 (PTO Bd. App. 1979). It is submitted that the language in claim 64 is proper and should be given patentable weight in the prosecution of the instant patent application.

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Applicants request examination and reconsideration of the application as amended.  
Allowance of claim 64 as well as claims 30, 32-37, 46-53, 55-63 and 65 at an early date is  
solicited.

Respectfully submitted,

6/6/06  
Date

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